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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/607,627

06/27/2003

Pavel Kouznetsov

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WOODCOCK WASHBURN LLP (MICROSOFT CORPORATION)
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

EXAMINER

HOFFMAN, BRANDON S

ART UNIT

PAPER NUMBER

2136

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/607,627	Applicant(s) KOUZNETSOV ET AL.	
	Examiner Brandon S. Hoffman	Art Unit 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/27/03
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10-10-03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on October 10, 2003, is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Specification

2. The disclosure is objected to because of the following informalities: The disclosure is objected to because of the following informalities: the "CROSS-REFERENCES TO RELATED APPLICATIONS" and "CO-PENDING APPLICATIONS" sections need updated to reflect applications that have matured into patents. This is found on pages 1 and 2 of the specification. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 6 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claims 6 and 21 recite the limitation "the attachment portion." There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 16-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 16-30 are not limited to tangible embodiments. In view of applicants' disclosure, specification page 9, line 17 through page 10, line 7, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., RAM, ROM, EPROM) and intangible embodiments (e.g., carrier wave, acoustic, RF). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-30 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22 of copending Application No. 10/607898. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application concerns a rights-managed document, whereas 10/607898 concerns a rights-managed email. The remaining limitations are identical

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Peinado et al. (U.S. Patent No. 7,103,574).

Regarding claims 1 and 16, Peinado et al. teaches a rights-managed document/computer-readable medium having protected content from an author thereof,

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whereby a recipient of the document can render the protected content with a corresponding license if the recipient satisfies terms set forth in the license, the document comprising:

- A storage portion having a message that the document is rights management protected (col. 14, lines 18-25); and
- A custom data portion having a section including the protected content, wherein the recipient if enabled can render the protected content in the custom data portion and if not enabled can only review the storage portion having the message (col. 14, lines 26-46).

Regarding claims 2 and 17, Peinado et al. teaches wherein the custom data portion further has a section including rights data relating to the protected content, the rights data setting forth each entity that has rights with respect to the protected content, and for each such entity a description of such rights (col. 2, lines 61-64).

Regarding claims 3 and 18, Peinado et al. teaches wherein the protected content in the custom data portion is encrypted according to a cryptographic key, and the rights data includes a decryption key (KD) for decrypting the encrypted content (col. 6, lines 48-52 and col. 7, lines 4-10).

Regarding claims 4 and 19, Peinado et al. teaches wherein the decryption key (KD) is encrypted according to a public key of a rights management (RM) server (PU-

RM) operated by or on behalf of an organization of the author to result in (PU-RM(KD)), where only the RM server can access (KD) from (PU-RM(KD)) with a corresponding private key (PR-RM) (fig. 5B, ref. num 521 and col. 23, lines 29-35).

Regarding claims 5 and 20, Peinado et al. teaches wherein the protected content in the custom data portion comprises multiple alternative forms of a body of the document, whereby the recipient can select from among the alternative forms when rendering the protected content (col. 13, line 63 through col. 14, line 4).

Regarding claims 6 and 21, Peinado et al. teaches wherein the protected content in the attachment portion is compressed to reduce an overall size thereof (col. 7, lines 41-47).

Regarding claims 7 and 22, Peinado et al. teaches comprising a word processing document (col. 14, lines 9-13).

Regarding claims 8 and 23, Peinado et al. teaches wherein the custom data further has a section including an obtained license (fig. 4, ref. num 38).

Regarding claims 9 and 24, Peinado et al. teaches wherein the custom data further has a section including a transform specifying each section of custom data that is encrypted and each section of custom data with a license by which a decryption key

(KD) may be obtained (col. 16, lines 39-43).

Regarding claims 10 and 25, Peinado et al. teaches wherein the custom data further has a section including a transform specifying each section of custom data that is compressed and how the section is compressed (col. 16, lines 39-43 and col. 7, lines 23-24).

Regarding claims 11 and 26, Peinado et al. teaches a method/computer-readable medium for an enabled recipient to handle a received rights-managed document with protected content from an author, the document comprising a storage portion having a message that the document is rights management protected and a custom data portion having a section including the protected content (col. 14, lines 18-26), the method comprising:

- Receiving the document (fig. 5A, ref. num 501);
- Recognizing that the document has the protected content in the custom data portion thereof (fig. 5A, ref. num 505);
- Discounting the storage portion of the document (fig. 5A, ref. num 509, 511, and 513); and
- Examining the custom data portion of the document and proceeding based thereon to render the protected content in the custom data portion (fig. 5A, ref. num 515 through fig. 5B).

Regarding claims 12 and 27, Peinado et al. teaches

- Wherein the protected content is encrypted and is decryptable according to a decryption key (KD) (col. 6, lines 48-52 and col. 7, lines 4-10),
- Wherein the custom data portion further has a section including rights data relating to the protected content, the rights data including (KD) and setting forth each entity that has rights with respect to the protected content and for each such entity a description of such rights (col. 2, lines 61-64), and
- Wherein rendering the protected content in the custom data portion comprises:
 - Retrieving the rights data in the custom data portion of the document (fig. 6, ref. num 601);
 - Forwarding the retrieved rights data to a rights management (RM) server, such RM server for determining that the recipient is an entity listed in the rights data and issuing to the recipient a license corresponding to the protected content to the recipient based on the rights data, such license specifying rights the recipient has with respect to the protected content as determined from the rights data and also including (KD) from the rights data encrypted in a manner decryptable by the recipient (fig. 5B, ref. num 529 and fig. 6, ref. num 603);
 - Reviewing the issued license to determine that the recipient has a right to render the protected content of the custom data portion of the document (fig. 6, ref. num 607);
 - Retrieving (KD) from the license (col. 4, lines 55-57);

- Decrypting the protected content with (KD) (fig. 5B, ref. num 533); and
- Rendering the decrypted content (fig. 5B, ref. num 535).

Regarding claims 13 and 28, Peinado et al. teaches further comprising storing the issued license in a section of the custom data portion of the document (fig. 4, ref. num 38).

Regarding claims 14 and 29, Peinado et al. teaches wherein the protected content in the custom data portion comprises multiple alternative forms of a body of the document, the method further comprising selecting from among the alternative forms when rendering the protected content (col. 13, line 63 through col. 14, line 4).

Regarding claims 15 and 30, Peinado et al. teaches wherein the protected content in the custom data portion is compressed to reduce an overall size thereof, the method further comprising decompressing the protected content (col. 7, lines 41-47).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon S. Hoffman whose telephone number is 571-272-3863. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser G. Moazzami can be reached on 571-272-4195. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Branda Hoff

BH

NASSER MOAZZAMI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

MS
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